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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,546	03/29/2001	Frederik Albert Buijtenhuijs	570-13 CON (AFP 2318)	4200

7590

06/03/2003

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EXAMINER

CINTINS, IVARS C

ART UNIT

PAPER NUMBER

1724

DATE MAILED: 06/03/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/820,546

Applicant(s)

Buijtenhuijs et al.

Examiner

Ivars Cintins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Mar 27, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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Upon reconsideration, particularly in view of Applicant's arguments presented on pages 2-3 of the response filed February 21, 2003, it is agreed that the concept of regenerating the treatment material such that the hydrophobic substance is not freed therefrom is described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention. Accordingly, the 35 U.S.C. 112, first paragraph, rejection contained in the previous Office action is hereby withdrawn.

It is also agreed that the subject matter added to page 4, line 27 of the specification via the amendment filed March 27, 2003 does not constitute new matter, because this concept was present in original claim 12 of this application.

The objection to the disclosure for improperly referring to this application as a continuation of prior application Serial No. 08/381,828 is, however, maintained for the following reasons. As pointed out, in said previous Office action, in order to qualify as a continuation, the disclosure presented in the second application must be the same as that of the original application (M.P.E.P. § 201.07). While specification pages 6-11 of the instant application appear to be identical to the corresponding pages in prior application Serial No. 08/381,828; pages 1-5 of this application are significantly different from the

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corresponding pages in the prior application. For example, pages 1-5 of this application broadly describe the use of a material for the extraction of hydrophobic constituents from an aqueous solution; whereas prior application Serial No. 08/381,828 is limited to a polymer for performing this function (compare page 1, lines 4 and 6 of the prior application with the corresponding page and lines of the instant application). Also, the hydrophobic immobilized material in this application is disclosed as being a solid or a liquid (see page 2, lines 26-27); whereas this immobilized material is only disclosed as being a liquid in the prior application (see page 3, lines 7-8, of the prior application). Accordingly, since the disclosure of this application is not the same as that of the prior application, it is not deemed to be a proper continuation of said prior application.

Furthermore, since claims 1-13 of this application recite a "material" (i.e. not necessarily a polymer) containing an immobilized hydrophobic "substance" (i.e. not necessarily a liquid), these claims are only entitled to the benefit of the filing date of this application (i.e. March 29, 2001), not to the benefit of the filing date of prior application Serial No. 08/381,828; and therefore, WO 94/03249, having a publication date

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of February 17, 1994, is deemed to be available as prior art against these claims.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-13 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by WO 94/03249.

The disclosure is objected to because of the following informalities:

(1) the use of a comma, instead of a period, to represent a decimal point throughout the specification (e.g. page 2, lines 4 and 24; page 4, lines 20 and 32; page 5, lines 24-28; page 6, lines 19 and 24; page 8, lines 27-28; page 9, lines 18 and 25-26; page 10, lines 5 and 33; page 11, lines 28-34, etc.) is improper.

(2) the term "immobilized" is misspelled throughout the specification (e.g. page 2, lines 4, 26 and 27; page 3, lines 4, 9 and 16; etc.). Appropriate correction is required.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to I. Cintins whose telephone number is (703) 308-3840. The examiner can

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normally be reached on Monday through Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Thomas Dunn, can be reached at (703) 308-3318.

The fax phone numbers for this art unit are: (703) 872-9311 for "Official" faxes after Final Rejection; (703) 872-9310 for all other "Official" faxes; and (703) 872-9492 for "Draft" and other "Unofficial" faxes.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.



**Ivars C. Cintins**  
**Primary Examiner**  
**Art Unit 1724**

I. Cintins  
May 31, 2003